PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Renes et al.

Serial No.: 09/981,213

Filed: October 17, 2001

For: INSURANCE FOR CESSATION OF PERSONAL CONTRACT

Confirmation No.: 5776

Examiner: T. Nguyen

Group Art Unit: 3626

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BRIEF ON APPEAL

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Sir:

This Brief on Appeal is submitted as a single copy pursuant to 37 C.F.R. § 41.37, and in the format required by 37 C.F.R. § 41.37(c)(1). Paperwork to charge the amount of $310.00 to applicant's credit card for the fee under 37 C.F.R. § 41.20(b)(2) for filing a brief in support of an appeal is enclosed. Please apply any charges not covered, or any credits, in connection with the filing of this Appeal Brief to Deposit Account No. 20-1469.

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I. REAL PARTY IN INTEREST

The real parties in interest in the present pending appeal are Mr. Johan Renes and Mr. Allen C. Turner.

II. RELATED APPEALS AND INTERFERENCES

Neither Appellant is aware of any prior or pending appeal or interference that would directly affect, be directly affected by, or have any bearing on the Board's decision in the present pending appeal.

III. STATUS OF THE CLAIMS

Claims 1-19 are pending in the application.

Claim 20 was cancelled without prejudice or disclaimer.

Claims 1-19 stand rejected.

No claims are allowed.

The rejection of claims 1-19 is being appealed.

IV. STATUS OF AMENDMENTS

In the Advisory Action of September 14, 2011, the Examiner agreed to enter the amendments presented in the Amendment filed August 25, 2011.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Pursuant to 37 C.F.R. § 41.37(c)(1)(v), the following summary of claimed subject matter is made, referring to the specification by page and line number.

A) Independent claim 9 is directed to: "[a] method comprising:

gathering data (Specification (as-filed) at page 6, lines 3-9 and lines 19-20, and page 8, lines 3-4, lines 9-11, and lines 24-30) about two or more natural persons entering into a cohabitation agreement (Id., at page 3, lines 22-25);

entering the data into a computer (Id., at page 8, lines 3-11 and lines 25-30);

calculating, with the computer (Id., at page 8, lines 10-13 and lines 17-30), a periodic amount to be charged a prospective participant for insurance covering at least some financial consequences of the untimely ending of a cohabitation agreement (Id., at page 3, line 26 – page 4, line 1) between the two or more natural persons (Id. at page 5, line 7 - page 6, line 19, page 8, lines 17-30);

charging the periodic amount in an insurance program over a period of time (Id. at page 5, line 26 through page 6, line 2, page 8, line 13-15, and original claim 12); and

administering the insurance program with the computer (Id. at page 4, lines 6-7, page 5, line 26 through page 6, line 2, and page 8, lines 5-8) so that upon ending of the cohabitation agreement, payments covering at least some financial consequences of the ending of the cohabitation agreement are made (Id. at page 9, lines 1-5),

wherein the two or more natural persons entering into a cohabitation agreement are unmarried (Id., at page 3, lines 22-25; see also, page 2, lines 14-15, also, *compare*, original dependent claim 2, which further defined the original "contractual relationship [insured to be] a marital contract"), and

wherein the financial consequences comprise, in addition to legal fees (Id., page 5, lines 7-11), financial consequences selected from the group consisting of moving costs, a former partner's education, health insurance premiums, life insurance premiums, and combinations of any thereof (Id., page 5, lines 7-11, and page 7, lines 22-24)."

B) Independent claim 12 is directed to "[a] method comprising:

gathering data about two or more natural persons entering into a contractual relationship [such as marriage, see dependent claim 2] (Id. at page 6, lines 3-9 and lines 19-20, and page 8, lines 3-4, lines 9-11, and lines 24-30);

entering the data into a computer (Id., at page 8, lines 3-11 and lines 25-30);

calculating, with the computer (Id., at page 8, lines 10-13 and lines 17-30, and page 9, lines 13-18), a periodic amount to be charged a prospective participant for insurance covering at least some financial consequences in addition to legal fees (Id., at page 5, lines 7-11) of the untimely ending of a contractual relationship between the two or more natural persons;

charging that periodic amount in an insurance program over a period of time (Id., at page 8, lines 13-15, and page 9, line 13, through page 10, line 28); and

administering the insurance program with the computer (Id., at page 4, lines 6-7, page 5, line 26 through page 6, line 2, page 8, lines 5-8, and page 9, line 13, through page 10, line 28) so that upon ending of the contractual relationship (Id., at and page 10, lines 21-28), payments covering at least some financial consequences of the ending of the contractual relationship are made as determined by the computer (Id., at page 9, lines 1-5 and page 10, lines 21-28),

wherein the financial consequences comprise, in addition to legal fees, financial consequences selected from the group consisting of moving costs, a former partner's education, health insurance premiums, life insurance premiums, and combinations of any thereof (Id., page 5, lines 7-11 and page 7, lines 22-24)."

VI. GROUNDS OF REJECTION TO BE REVIEWED

The pending claims are rejected for allegedly being obvious. Specifically, the issues for review are:

A) Whether claim 9 is rendered obvious under 35 U.S.C. § 103(a) by DuBroff "Divorce Insurance", *Barrister* 3, pp. 16, 45-47 (1976), U.S. Patent 4,839,804 to Roberts et al., Golden "Breaking Up Without Going Broke", Boston Globe, (March 10, 1996), and Malveaux (Premarital 'insurance.' - prenuptial and cohabitation agreements);

B) Whether claims 1-8, 10-16, and 18-19 are rendered obvious under 35 U.S.C. § 103(a) over DuBroff, Roberts, Golden, and Grande (The Proper Use of Insurance); and

C) Whether claim 17 is rendered obvious under 35 U.S.C. § 103(a) by DuBroff, Roberts, Golden, Grande, and US 2005/0038681 to Covert?

VII. ARGUMENT

Legal standard.

Under the Patent Act, a person "shall be entitled to a patent" unless one of the conditions for patentability set forth in the statute is not satisfied. 35 U.S.C. § 102. For example, a person otherwise entitled to a patent may not obtain the patent "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a).

The Examiner bears the initial burden of presenting a *prima facie* case of unpatentability under 35 U.S.C. § 103. In re Piasecki, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if that burden is met does the applicant have the burden of coming forward with evidence or argument. Id. "If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If a *prima facie* case of unpatentability has been articulated by the Examiner,

patentability is determined on the totality of the record, by a preponderance of evidence, and with due consideration to the persuasiveness of all rebuttal arguments and evidence offered by the applicant. Id.; In re Sernaker, 702 F.2d 989, 996-7 (Fed. Cir. 1983). On appeal, "the Board reviews the particular finding(s) contested by an appellant ***anew*** in light of all the evidence and argument on that issue." Ex parte Frye, Appeal No. 2009-006013, 10 (B.P.A.I. 2010) (precedential) (emphasis added).

To establish a *prima facie* case of obviousness, the subject matter of a claim "as a whole" must have been obvious in view of the cited references. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1537 (Fed. Cir. 1983). Thus, the cited references, or "the inferences and creative steps that a person of ordinary skill in the art would [have] employ[ed]" at the time of the invention, must teach or suggest all of the claim elements. K.S.R. Intern. Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007); In re Wilson, 424 F.2d 1382, 1385 (C.C.P.A. 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art."); *see also* Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 449 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987) (claimed invention as a whole includes every element of claim). Also, properties of a claimed invention that are disclosed in the application, even if they are inherent or not explicitly recited in a claim, must be considered part of the claimed invention "as a whole." In re Antonie, 559 F.2d 618, 620 (C.C.P.A. 1977); *see also* In re Rijckaert, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (obviousness cannot be predicated on inherent features that are not known).

Moreover, in ascertaining whether the claimed subject matter as a whole would have been obvious, the Examiner must also determine the content of the prior art "as a whole." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1550-1552 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Thus, a reference cannot be combined to render a claim obvious if the reference teaches away from the subject matter of the claim. In re Grasselli, 713 F.2d 731, 743 (Fed. Cir. 1983). A reference "teaches away" from a claim when a person of ordinary skill, upon reading the reference, "would be led in a direction divergent from the path . . . taken" by the inventor. In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994).

After arriving at an understanding of the subject matter of the claim as a whole that

accounts for every element of the claim and disclosed inherent properties of its subject matter, the Examiner must articulate a reason or motivation that would have existed at the time of the invention to modify or combine the known elements in the prior art as a whole to arrive at the claimed subject matter. K.S.R. Intern. Co., 550 U.S., at 418. There would have been no such motivation when the proposed modification or combination would have rendered the prior art unsatisfactory for its intended purpose. In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984).

A) Claim 9 is rejected under 35 U.S.C. §103(a) as assertedly being unpatentable over DuBroff "Divorce Insurance", *Barrister* 3, pp. 16, 45-47 (1976), U.S. Patent 4,839,804 to Roberts et al., Golden (Golden "Breaking Up Without Going Broke", Boston Globe, March 10, 1996), and Malveaux (Premarital 'insurance.' - prenuptial and cohabitation agreements). The rejection should be reversed because the cited references, or the inferences and creative steps that a person of ordinary skill in the art would have employed at the time of the invention, do not teach or suggest all of the claim elements, and there would have been no motivation to combine the references as suggested by the Examiner.

(1) Separate argument supporting claim 9

(i) Claim construction

As previously identified, independent claim 9 is explicitly directed to addressing the situation where a cohabiting unmarried couple is living under the terms of a "cohabitation agreement." The Examiner asserts that a "cohabitation agreement" is the same as a marriage. (Advisory Action of September 14, 2011, p. 4-5). Appellants acknowledge the Examiner's duty under the examination rules of the U.S.P.T.O. to give claim 9 its broadest reasonable interpretation. *See* M.P.E.P. § 2111. However, this broadest reasonable interpretation must be consistent with the Specification as it would be interpreted by one of ordinary skill in the art. Phillips v. AWH Corp., 415 F.3d 1303, 1316 (Fed. Cir. 2005). Appellant respectfully asserts that the Examiner's interpretation of the term "cohabitation agreement" is inconsistent with common parlance and the meaning one of ordinary skill in the art would give this term, particularly in view of the Specification. Specification, at page 3, lines 22-25. One of ordinary skill in the art

would understand (and as the term is used in common parlance) a "cohabitation agreement" is by definition not a marriage.

(ii) Analysis

The Examiner found (Final Office action of May 25, 2011, p. 3) that,

> As per claim 9 of the instant application, DuBroff teaches a method of providing insurance ..., comprising:
> (a) collecting data from a couple at the time of marriage (reads on 'two ... persons entering into a cohabitation agreement') (page 45 column 2 paragraph 2); [and]
> (b) calculating various data required for insurance (page 47 column 2-3),

but that

> DuBroff does not teach: entering the data into a computer.

Appellants agree that DuBroff does not teach entering data into a computer. Appellants respectfully disagree with the other factual findings attributed to DuBroff by the Examiner.

First, page 45, column 2, paragraph 2 of DuBroff is not discerned as disclosing anything about "collecting data" from an unmarried couple. In contrast, the portion of the paragraph that the Examiner relies upon (Advisory Action of September 14, 2011, p. 3) recites:

> Through periodic payments made over the course of the first few years after divorce, it would provide temporary minimal child support.

The Examiner asserts that "a payment suggests a monetary amount from a source [which] represents at least two forms of 'data' to be collected. (Id.) The appellants dispute that this factual finding. See, also, In re Rijckaert, 9 F.3d at 1534 (obviousness cannot be predicated on inherent features that are not known).

Second, page 47, columns 2-3 of DuBroff do not appear to relate to "calculating various data required for insurance". Actually, the cited paragraph recites:

> As I've shown, the need for some type of divorce insurance is acute. Divorce insurance, family support insurance, child welfare insurance - whatever you like to call it - is an idea whose time has come. It's now up to the actuaries, the insurance plan executives, the bankers and the far sighted lawyers among us who are concerned with helping families - even divorced families - live in continuity, dignity and security. It's up to us to press for a workable plan.

The appellants thus dispute this factual finding.

Third claim 9 is directed to the situation wherein an unmarried couple enters into a cohabitation agreement (*e.g.*, a civil union between same sex couples). (See, also, Final Office action, pp. 4-5). The disclosure of DuBroff appears to be limited to divorces between married couples and does not teach the claimed contractual relationships between unmarried persons. The Examiner is interpreting "marriage" to be a "cohabitation agreement." (Advisory Action of September 14, 2011, p. 4-5). As previously discussed, common English usage dictates that a "cohabitation agreement" is by definition, not a marriage.

Appellants agree that U.S. Patent 4,839,804 to Roberts discloses entering insurance application data into a computer for processing.

According to the Examiner (Final Office action, p. 3),

> DuBroff further teaches:
> (c) calculating a premium (page 46 column 3 paragraph 3), wherein the insurance policy payouts to cover the costs (reads on 'at least some financial consequences') incurred in a divorce (reads on 'untimely ending of a cohabitation agreement') (page 16).
> DuBroff does not teach:
> calculating, with the computer.

Although Appellants agree that DuBroff does not teach calculating with the computer, Appellants respectfully disagree with the other factual findings attributed to DuBroff by the Examiner. Specifically, the cited paragraph (*i.e.*, at page 46, column 3, paragraph 3) recites:

> If the [divorce insurance policy] were made mandatory for all married people (or all who have children), it could be administered like social security, with painless deductions taken from each applicable wage-earner's paycheck. (Thus, when both husband and wife work, both would be expected to contribute – a factor which should make such an insurance policy even more palatable.)

or (if the appellants misunderstood the specific citation):

> Another plan that has been suggested is a voluntary short-term trust with no withdrawal privileges, to be set up for the children and/or needy spouse; the government would add incentive in the form of tax deductions for both the principal and the interest.

Again, the cited portion of DuBroff is not believed to disclose "calculating . . . a periodic

amount to be charged a prospective participant for insurance covering at least some financial consequences of the untimely ending of a cohabitation agreement between the two or more [unmarried] natural persons". The appellants thus dispute this factual finding.

Again, as previously discussed, claim 9 is directed to the situation of the untimely demise of a cohabitation agreement between unmarried persons, and the disclosure of DuBroff is limited to divorces between married couples.

Appellants agree that Roberts teaches using a computer to determine the amount of an insurance premium.

According to the Examiner (Final Office action, p. 4),

> DuBroff further teaches:
> (d) charging the premium amount (page 46 column 3 paragraph 3); [and]
> (e) providing payout in case of divorce (page 16 and throughout).
>
> DuBroff does not teach:
> administering the insurance program with the computer.

Appellants agree that DuBroff does not teach administering an insurance program with a computer. Applicants further agree that DuBroff discloses taking deductions for "the program" from each applicable wage-earner's paycheck.

Appellants respectfully disagree with the other finding attributed to DuBroff by the Examiner. First, as previously discussed, divorce of a married couple is different than the separation of an unmarried couple living under a cohabitation agreement between unmarried persons. DuBroff recognizes this difference by, for example, stating "An insurance company might offer a major casualty insurance program, with regular payments, payable only in the event of a legal divorce decree." (DuBroff, p. 45, col. 2, 2nd full paragraph, emphasis added). DuBroff even "teaches away" from an insurance policy for unmarried couples, by stating "Some insurance companies fear that financially distressed couples might divorce and live [together] out of wedlock to obtain their benefits." (Id., p. 45, col. 3, 1st full paragraph). In contrast, the method of claim 9 specifically provides insurance for unmarried couples living under such circumstances who decide it is best to split up.

Second, the appellants respectfully submit that the divorce insurance policy aspect of

DuBroff "pays out" child support or maintenance payments, not the specifically identified items of claim 9. DuBroff's divorce insurance policy is provided as "a way of insuring that children of divorce will get at least minimal monetary support" (DuBroff, p. 16) by "creat[ing] a fund that would cushion child support payments provide temporary maintenance until both spouses are fully self-supporting" (Id., p. 45, col. 2, 1st paragraph). Specifically the "insurance" of DuBroff

> "provide[s] temporary minimal child support. It could insure our children from becoming public charges, save our unemployable divorcees from hasty remarriages, keep our middle-income marriage casualties from the poverty rolls. Further it could protect our guilt-ridden father from avoiding the children because of delinquent payments. It could eliminate the family court support and non-support hostilities that cause relationships of an entire family – including the children – to deteriorate. It could even help the father who gets custody of the children and must provide household care while he works."
>
> (Id., col. 2, first full paragraph, emphasis added).

This is confirmed later on in DuBroff where it is stated that

> If the [divorce insurance policy] were made mandatory for all married people (or all who have children), it could be administered like social security, with painless deductions taken from each applicable wage-earner's paycheck. (Thus, when both husband and wife work, both would be expected to contribute – a factor which should make such an insurance policy even more palatable.)
>
> (Id., p. 46, col. 3, 2nd full paragraph, emphasis added).

Why would a married couple who do not have children want to pay the child support insurance of DuBroff?

And further, DuBroff points out that

> Actually, a rider can even now be attached to any existing life insurance policy stipulating that its cash surrender value be paid, in the event of a divorce, over a limited time period and solely for child support. A stipulation could be made in the rider that the payments be distributed only to the custodial parent, or to a guardian named in the rider or appointed by the court in the event of divorce.
>
> (Id., p. 46, col. 3, last paragraph, emphasis added).

Not only does DuBroff state "solely for child support", but one only pays the child support payments to the children's guardian.

Appellants agree that Roberts et al. discloses using a computer to administer an insurance policy to provide automated payout.

According to the Office (Final Office action, p. 4),

> DuBroff does not explicitly teach:
>
> wherein the two or more natural persons entering into a cohabitation agreement are unmarried.

But, the Examiner found that DuBroff teaches providing the insurance coverage to unmarried people who have children citing page 46, column 3, paragraph 2. Appellants respectfully disagree with this interpretation of the reference and finding. The cited paragraph in its entirety is as follows:

> If the [divorce insurance policy] were made mandatory for all married people (or all who have children), it could be administered like social security, with painless deductions taken from each applicable wage-earner's paycheck. (Thus, when both husband and wife work, both would be expected to contribute – a factor which should make such an insurance policy even more palatable.)

(Id., p. 46, col. 3, 2nd full paragraph).

It is respectfully contended that reading this paragraph "as a whole," the only reasonable interpretation is that DuBroff was stating that the divorce insurance policy should be mandatory for at least "all [married people] who have children." The previous "all" referred specifically to "all married people". The rest of the paragraph specifically talks about husbands and wives, who are by definition married. A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d at 1550-1552..

The Examiner then finds that Golden teaches providing coverage to unmarried couples, citing page 2, paragraph 17. As the finding is understood, Appellants respectfully dispute it. Golden is actually directed to "legal insurance" that happens to cover the legal fees associated with divorce (see, e.g., page 2, ¶¶ 11-15 of Golden). There is no disclosure in Golden of coverage of "financial consequences [that] comprise, in addition to legal fees, financial consequences selected from the group consisting of moving costs, a former partner's education,

health insurance premiums, life insurance premiums, and combinations of any thereof" as required by the claim.

DuBroff however explicitly teaches away from the combination proposed by the Examiner by the teaching that "An insurance company might offer a major casualty insurance program, with regular payments, payable only in the event of a legal divorce decree." (DuBroff, p. 45, col. 2, 2nd full paragraph, emphasis added). A legal divorce decree can only be issued to people who were married. DuBroff further provides that "Some insurance companies fear that financially distressed couples might divorce and live [together] out of wedlock to obtain their benefits." (Id., p. 45, col. 3, 1st full paragraph, emphasis added)). In contrast, the method of claim 9 specifically provides for insurance under such circumstances.

At the time the invention was made, one of ordinary skill in the art would not have combined the teachings of DuBroff and Golden as suggested by the Examiner. DuBroff specifically teaches against providing insurance to unmarried people. Furthermore, reading DuBroff, there could have been no reasonable expectation of success in providing such services to unmarried people who are entering into a cohabitation agreement between married persons as is required by claim 9. *K.S.R., supra.*

On page 5 of the Office action, it was found that "DuBroff further teaches providing monetary payments for any use (page 45 column 2 paragraph 2)." Appellants respectfully disagree. As previously identified, the cited paragraph reads as follows:

> Such "insurance" - the family security guarantee plan - would be initiated at the time of marriage and used in the event of divorce to help provide a breathing period for both spouses to work out the future. Through periodic payments made over the course of the first few years after divorce, it would provide temporary minimal child support. It could insure our children from becoming public charges, save our unemployable divorcees from hasty remarriages, keep our middle income marriage casualties from the poverty rolls. Further, it could protect our guilt-ridden fathers from avoiding the children because of delinquent payments. It could eliminate the family court support and non-support hostilities that cause relationships of an entire family - including the children - to deteriorate. It could even help the father who gets custody of the children and must provide household care while he works. (Emphasis added).

As appellants read the cited paragraph, it is pretty squarely directed to child support

issues, not the specific elements of claim 9. The appellants thus dispute this factual finding.

Appellants agree that "DuBroff does not specifically teach using the money to pay legal fees as well as paying for a former partner's education."

On page 5 of the Office action, it was further found that "Malveaux also suggests recouping the cost of funding a former partner's law school (page 2 paragraph 1)." The appellants respectfully point out that the cited portion of Malveaux specifically relates only to "marriage agreements" and "spouses" not to unmarried people who are entering into a cohabitation agreement.

Again, there would be no reason to go against the teaching of the primary reference, DuBroff, and offer such a service to unmarried people. Claim 9 is not obvious. The totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of nonobviousness. *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986).

In contrast, however, the Examiner's argument is that if one were to first supplement DuBroff beyond its literal and reasonable disclosure, then combine the thus supplemented disclosure of DuBroff with Golden (to provide legal fee coverage and expand DuBroff, against its teachings, to include unmarried people), then expand that combined and supplemented coverage with an again revised version of Malveaux, and computerize the whole thing as per Roberts, one would arrive at the claimed invention. Appellants respectfully disagree. Such a combination could only be put together with impermissible hindsight. The reason that would have prompted the proposed combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based upon the appellants' disclosure as is apparently being done in this case. *K.S.R., supra.* Furthermore, no reason existed to combine the references as done by the Office, especially where the references (e.g., DuBroff) teach away from their combination.

Reversal of the rejection is courteously solicited.

(2) Argument supporting claim 12

Independent claim 12 and claims 1-8, 10, 13-16, and 18-19 dependent thereon are not obvious under 35 U.S.C. § 103(a) over DuBroff, Roberts, Golden, and Grande (The Proper Use

of Insurance).). The rejection should be reversed because the cited references, or the inferences and creative steps that a person of ordinary skill in the art would have employed at the time of the invention, do not teach or suggest all of the claim elements, and there would have been no motivation to combine the references as suggested by the Examiner.

On page 6 of the Final Office action, it was asserted that

> As per claim 12, DuBroff teaches a method of providing insurance (reads on "doing business") (page 16), comprising:
> (a) collecting data from a couple at the time of marriage (reads on "two ... persons entering into a contractual relationship") (page 45 column 2 paragraph 2);
> (b) calculating various data required for insurance (page 47 column 2-3).
> DuBroff does not teach: entering the data into the computer.

Appellants agree that DuBroff does not teach entering data into a computer. Appellants respectfully disagree with the other factual findings attributed to DuBroff by the Examiner.

Page 47, columns 2-3 of DuBroff do not appear to relate to "calculating various data required for insurance". Specifically, the cited paragraph recites:

> As I've shown, the need for some type of divorce insurance is acute. Divorce insurance, family support insurance, child welfare insurance - whatever you like to call it - is an idea whose time has come. It's now up to the actuaries, the insurance plan executives, the bankers and the far the sighted lawyers among us who are concerned with helping families - even divorced families - live in continuity, dignity and security. It's up to us to press for a workable plan.

The appellants thus dispute this factual finding.

Appellants agree that U.S. Patent 4,839,804 to Roberts discloses entering insurance application data into a computer for processing.

The Examiner goes to find that DuBroff further teaches:

> (c) calculating a premium (page 46 column 3 paragraph 3), wherein the insurance policy payouts to cover the costs (reads on 'at least some financial consequences') incurred in a divorce (reads on 'untimely ending of a cohabitation agreement') (page 16).
> DuBroff does not teach:
> calculating, with the computer.

Although Appellants agree that DuBroff does not teach calculating with the computer, Appellants respectfully disagree with the other factual findings attributed to DuBroff by the

Examiner. Specifically, the cited paragraph (*i.e.*, at page 46, column 3, paragraph 3) recites:

> If the [divorce insurance policy] were made mandatory for all married people (or all who have children), it could be administered like social security, with painless deductions taken from each applicable wage-earner's paycheck. (Thus, when both husband and wife work, both would be expected to contribute – a factor which should make such an insurance policy even more palatable.)

or (if the appellants misunderstood the citation)

> Another plan that has been suggested is a voluntary short-term trust with no withdrawal privileges, to be set up for the children and/or needy spouse; the government would add incentive in the form of tax deductions for both the principal and the interest.

Again, the cited portion of DuBroff is not believed to disclose "calculating . . . a periodic amount to be charged a prospective participant for insurance covering at least some financial consequences of the untimely ending of a cohabitation agreement between the two or more natural persons". The appellants thus dispute this factual finding.

DuBroff and Roberts do not teach:

> insurance covering at least some financial consequences in addition to legal fees of the untimely ending of a contractual relationship between the two or more natural persons.

Then the Examiner asserts that "Golden teaches paying for legal fees in case of divorce (page 2 paragraph 15)." Golden is actually directed to "legal insurance" that happens to include coverage for legal fees associated with divorce (see, e.g., page 2, ¶¶ 11-15 of Golden). Golden does not disclose coverage of "financial consequences comprise, in addition to legal fees, financial consequences selected from the group consisting of moving costs, a former partner's education, health insurance premiums, life insurance premiums, and combinations of any thereof" as required by the claims.

According to the Examiner (Final Office action, p. 7),

> DuBroff further teaches:
> (d) charging the premium amount (page 46 column 3 paragraph 3); [and]
> (e) providing payout in case of divorce (page 16 and throughout).
> DuBroff does not teach:
> administering the insurance program with the computer.

Appellants agree that DuBroff does not teach administering the insurance program with a computer as required by the claims. Appellants further agree that DuBroff discloses taking deductions for "the program" from each applicable wage-earner's paycheck.

Appellants respectfully disagree with the other finding attributed to DuBroff by the Examiner. The appellants respectfully submit that the divorce insurance policy aspect of DuBroff "pays out" child support payments, not the specifically identified items of claim 12. DuBroff's divorce insurance policy is provided as "a way of insuring that children of divorce will get at least minimal monetary support" (DuBroff, p. 16) by "creat[ing] a fund that would cushion child support payments provide temporary maintenance until both spouses are fully self-supporting" (Id., p. 45, col. 2, 1st paragraph). Specifically the "insurance" of DuBroff

> provide[s] temporary minimal child support. It could insure our children from becoming public charges, save our unemployable divorcees from hasty remarriages, keep our middle-income marriage casualties from the poverty rolls. Further it could protect our guilt-ridden father from avoiding the children because of delinquent payments. It could eliminate the family court support and non-support hostilities that cause relationships of an entire family – including the children – to deteriorate. It could even help the father who gets custody of the children and must provide household care while he works.
>
> (Id., col. 2, first full paragraph, emphasis added).

And further, DuBroff points out that

> Actually, a rider can even now be attached to any existing life insurance policy stipulating that its cash surrender value be paid, in the event of a divorce, over a limited time period and solely for child support. A stipulation could be made in the rider that the payments be distributed only to the custodial parent, or to a guardian named in the rider or appointed by the court in the event of divorce.
>
> (Id., p. 46, col. 3, last paragraph, emphasis added).

Not only is this "solely for child support", but one only pays the child support payments to the children's guardian.

Appellants agree that Roberts et al. discloses using a computer to administer an insurance policy to provide automated payout.

DuBroff, Roberts, and Golden do not teach:

> wherein the financial consequences comprise, in addition to legal fees, financial consequences selected from the group consisting of moving costs, a former partner's education, health insurance premiums, life insurance premiums, and combinations of any thereof.

The Examiner found, in "DuBroff, the insurance payout may be used by the beneficiary for any purpose, including maintaining a household (page 45 and throughout)." (Final Office action, p. 8). Appellants respectfully disagree and dispute this factual finding. Reviewing page 45 of DuBroff, one sees mention of "child support," "Aid to Families with Dependent Children," "child-welfare recipient families," "support payments," "support orders," "paying for the children of divorce," "creat[ing] a fund to cushion child support payments and provide temporary maintenance," "minimal child support," and so forth. No mention appears to be made of support or maintenance separate from children, let alone "moving costs, a former partner's education, health insurance premiums, life insurance premiums, and combinations of any thereof" as specifically required by the claim.

The only disclosure of DuBroff of which the appellants are aware in this regard is in DuBroff's statement at page 46, columns 2-3, that "convertible bonds that would be returned in a number of small payments only in the event of a divorce or at some predetermined milestone [e.g.,] at the 25th anniversary" could "provide money for a well-earned vacation trip." But this is specifically identified by DuBroff as "another way to provide support insurance" and not part of an insurance program as envisioned by claim 12. (Id.)

The Examiner found that "Golden teaches providing divorce insurance to pay for legal fees (page 2, paragraphs 15- 16)." (Final Office action, p. 8). Appellants respectfully disagree and dispute this factual finding. As previously shown, Golden merely teaches providing legal insurance coverage for incidents that incur legal fees, such as divorce.

The Examiner found that "Grande teaches that upon divorce, health and life insurance premiums must be paid as part of the divorce settlement (pages 652-653)." (Final Office action, p. 8). Appellants respectfully disagree and dispute this factual finding. The cited portion of Grande actually states that under some circumstances after divorce of a couple, the divorce decree may require some health insurance coverage of the non-working spouse and the life insurance situation should be adjusted accordingly.

Grande is still after the fact triage, not prophylaxis for the event as is envisioned by the appellants' claim 12. Furthermore, Grande discloses that "a separate [health insurance] policy for the spouse will have to be obtained." And, "if the employee continues on his group plan and has to buy single coverage for the spouse, the cost of double coverage will be very high." Similar problems are identified for life insurance. These exact problems however are addressed and overcome by appellants' claimed invention.

The Examiner's argument is that if one were to first supplement DuBroff beyond what it reasonably discloses, then combine the "supplemented" disclosure of DuBroff with Golden (to provide legal fee coverage), then expand that combined and supplemented coverage with Grande, and computerize the whole thing as per Roberts, one would arrive at the method of claim 12. Appellants respectfully disagree, and submit that such a combination could only be put together with impermissible hindsight.

The Examiner argues that the reason for doing so would be to provide health and life insurance coverage to divorced people. However, as shown by Grande, such is already being done by way of a divorce decree. Thus, no reason existed to combine the references as done by the Office in this rejection.

The Examiner found that "As per claim 1, DuBroff suggests providing payouts to people who are married or have children (page 46 column 3 paragraph 2)." (Final Office action, p. 8). Appellants respectfully disagree and dispute this factual finding. Such payouts of DuBroff are to the custodial parent after a divorce and the payments provide for the support and maintenance of the children of the divorced couple. DuBroff, supra.

The Examiner found that "Golden also teaches a married couple (reads on "living together") (paragraph 15). Gold[en] further explicitly teaches providing coverage to cohabiting couples (page 2 paragraph 17)." (Final Office action, p. 8). Appellants respectfully disagree and dispute this factual finding to the extent it goes beyond Golden being directed to legal insurance that happens to cover the legal fees associated with an incident, such as a divorce.

Reversal of the rejections is courteously solicited.

(3) Argument supporting claims 2-4, 6-8, 10, 11, 13, 16, 18, and 19

Solely for the purpose of this appeal, dependent claims 2-4, 6-8, 10, 11, 13, 16, 18, and 19 will not be separately argued, and will stand or fall with independent claim 12. Appellants respectfully note that a dependent claim is obvious only if the independent claim from which it depends is obvious. *See* In re Fine, 837 F.2d, at 1076.

Reversal of the rejections is courteously solicited.

(4) Argument supporting claim 5

Claim 5 recites:

The method according to claim 1, wherein said insurance program is part of another contract.

As with independent claim 12, from which claim 5 indirectly depends, claim 5 was rejected as allegedly being obvious under 35 U.S.C. § 103(a) over DuBroff, Roberts, Golden, and Grande.

To make the rejection, the Examiner found that "Golden also teaches that divorce insurance is offered as part of legal insurance (reads on "another contract") (paragraph 15)." (Final Office action, p. 9). Appellants respectfully disagree and dispute this factual finding.

Golden is a single legal insurance policy with coverage extending to include the legal fees associated with, *e.g.*, a divorce. It does not teach or suggest separate contracts or combining the claimed insurance with another contract.

This rejection thus fails to establish a *prima facie* case of obviousness. To establish such a case, the prior art reference itself (or references when combined) or "the inferences and creative steps that a person of ordinary skill in the art would [have] employ[ed]" at the time of the invention must teach or suggest all of the claim elements. *K.S.R.*., 550 U.S. at 418. The element of claim 5 is clearly missing from Golden. "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d at 1385. Accordingly, even if DuBroff were modified as suggested by the Examiner, this modification would not result

in the claimed method, and the obviousness rejection cannot be sustained.

Absent the element, the obviousness rejection fails. Reversal of the rejections is thus courteously solicited.

(5) Separate argument supporting claim 14

Claim 14 recites:

The method according to claim 12 wherein the periodic amount to be charged is calculated, in part, based upon the prospective participant's projected earnings.

As with independent claim 12, from which claim 14 depends, claim 14 was rejected as allegedly being obvious under 35 U.S.C. § 103(a) over DuBroff, Roberts, Golden, and Grande.

The Examiner acknowledged that "As per claims 14-15, DuBroff does not explicitly teach adjusting the premium based on income." (Id.)

The Office goes on to find however that "DuBroff recognizes that young people may not have money (page 46 column 3 paragraph 5)." (Id.) Appellants respectfully disagree with and dispute this factual finding. The appellants have read the cited portion and could find no such assertion.

Appellants also agree (again while preserving the reservations identified herein) that "DuBroff teaches government subsidies (page 46 column 2 paragraph 2)." (Id.)

Appellants also agree that "Gold[en] teaches that the government would pay the legal expenses for poor people."

The appellants dispute that this "(reads on "projected earnings") (paragraph 19)." (Id.) Such coverage, on its face, would specifically relate only to past earnings, which is clearly distinguished by claim 14, which relates to the computerized calculation of projected (*i.e.*, **future**) earnings of the participant.

This rejection fails to establish a *prima facie* case of obviousness. To establish such a case, the prior art reference itself (or references when combined) or "the inferences and creative steps that a person of ordinary skill in the art would [have] employ[ed]" at the time of the invention must teach or suggest all of the claim elements. *K.S.R.*, 550 U.S. at 418. The element

of claim 14 is clearly missing from the rejection.

The Examiner has failed to make a finding that "the periodic amount to be charged is calculated [by the claimed computer], in part, based upon the prospective participant's projected earnings". The Examiner also fails to provide any reasoning to explain why one skilled in the art would have been led to modify DuBroff's, Roberts', Golden's, or Grande's disclosure to include having the computer calculate the "periodic amount to be charged . . ., in part, based upon the prospective participant's projected earnings". "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d at 1385. Accordingly, even if DuBroff were modified as suggested by the Examiner, this modification would not result in the claimed method, and the obviousness rejection cannot be sustained.

(6) Separate argument supporting claim 15

Claim 15 recites:

The method according to claim 12 wherein the periodic amount to be charged is calculated, in part, based upon the prospective participant's partner's projected earnings.

As with independent claim 12, from which claim 15 depends, claim 15 was rejected as allegedly being obvious under 35 U.S.C. § 103(a) over DuBroff, Roberts, Golden, and Grande.

The Examiner acknowledged that "As per claims 14-15, DuBroff does not explicitly teach adjusting the premium based on income." (Id.)

The Office goes on to find however that "DuBroff recognizes that young people may not have money (page 46 column 3 paragraph 5)." (Id.) Appellants respectfully disagree with and dispute this factual finding. The appellants have read the cited portion and could find no such assertion.

Appellants also agree (again while preserving the reservations identified herein) that "DuBroff teaches government subsidies (page 46 column 2 paragraph 2)." (Id.)

Appellants also agree that "Gold[en] teaches that the government would pay the legal expenses for poor people."

The appellants dispute that this "(reads on "projected earnings") (paragraph 19)." (Id.) Such coverage, on its face, would specifically relate only to past earnings, which is clearly distinguished by claim 14, which relates to the computerized calculation of projected (*i.e.*, **future**) earnings of a participant.

Appellants also respectfully submit that this rejection fails to establish a *prima facie* case of obviousness. To establish such a case, the prior art reference itself (or references when combined) or "the inferences and creative steps that a person of ordinary skill in the art would [have] employ[ed]" at the time of the invention must teach or suggest all of the claim elements. *K.S.R. Intern. Co. v. Teleflex Inc.*, 550 U.S. at 418. The element of claim 15 is clearly missing from the rejection.

The Examiner has failed to make a finding that "the periodic amount to be charged is calculated [by the claimed computer], in part, based upon the prospective participant's partner's projected earnings". The Examiner also fails to provide any reasoning to explain why one skilled in the art would have been led to modify DuBroff's, Roberts', Golden's, or Grande's disclosure to include having the computer calculate the "periodic amount to be charged . . ., in part, based upon the prospective participant's partner's projected earnings". "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d at 1385. Accordingly, even if DuBroff were modified as suggested by the Examiner, this modification would not result in the claimed method, and the obviousness rejection cannot be sustained.

(7) Argument supporting claim 17

Claim 17 stands rejected under 35 U.S.C. §103(a) as assertedly being unpatentable over DuBroff, Roberts, Golden, Grande, and Covert (US 2005/0038681). The rejection should be reversed.

Claim 17 recites:

The method according to claim 16 wherein the changed circumstances are selected from the group consisting of inflation, deflation, educational achievement of one or more of the natural

persons, birth of a child, death of a child, disability of one or more of the natural persons, return on investment of investments made with the periodic amounts, and any combination thereof.

Appellants agree (again while preserving the reservations identified herein) that "DuBroff, Roberts, Golden, and Grande do not teach 'disability of one or more of the natural persons.'" (Final Office action, p. 11).

The Examiner asserts however that "Covert teaches providing insurance for the disability of a person (page 2, paragraph 0036)," and that "At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Covert within the embodiment of DuBroff, Roberts, Golden, and Grande with the motivation of tailoring premiums to the characteristics of the participant."

Again, no reason for the combination appears to be set forth by the Examiner. The proposed combination itself could only be put together as a result of impermissible hindsight. The rejection should thus be withdrawn.

SUMMARY

For at least the foregoing reasons, when the claims are properly construed as a whole and compared with the references cited by the Examiner, it is clear that the combination of these references does not yield the claimed invention with all the expressly recited elements and advantages of those claimed. Nor would a person of ordinary skill at the time the invention was made have been motivated to achieve these advantages by supplying missing elements to the cited references and combining them in the manner suggested by the Examiner. Accordingly, Appellants respectfully request reversal of the pending rejections.

Respectfully submitted,

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Enclosures: Claims Appendix
Evidence Appendix
Related Proceedings Appendix
Petition for Extension of Time

VIII. CLAIMS APPENDIX

1. The method according to claim 12, wherein the natural persons are living together.

2. The method according to claim 1, wherein said natural persons are legally married.

3. The method according to claim 2, wherein said untimely ending comprises a divorce between the natural persons.

4. The method according to claim 1, wherein said insurance program combines some financial consequences of the untimely ending of a contractual relationship between natural persons with other financial risks of the two or more natural persons.

5. The method according to claim 1, wherein said insurance program is part of another contract.

6. The method according to claim 1, further comprising providing as part of the insurance program a payment to the two or more natural persons at an end date of insurance coverage in the event the contractual relationship between the two or more natural persons does not end untimely.

7. The method according to claim 6, wherein said payment is dependent on investment of the periodic amounts paid on behalf of said natural persons for said insurance policy.

8. The method according to claim 12, wherein the prospective participant is one of the two or more natural persons.

9. A method comprising:

gathering data about two or more natural persons entering into a cohabitation agreement;

entering the data into a computer;

calculating, with the computer, a periodic amount to be charged a prospective participant for insurance covering at least some financial consequences of the untimely ending of a cohabitation agreement between the two or more natural persons;

charging the periodic amount in an insurance program over a period of time; and

administering the insurance program with the computer so that upon ending of the cohabitation agreement, payments covering at least some financial consequences of the ending of the cohabitation agreement are made,

wherein the two or more natural persons entering into a cohabitation agreement are unmarried, and

wherein the financial consequences comprise, in addition to legal fees, financial consequences selected from the group consisting of moving costs, a former partner's education, health insurance premiums, life insurance premiums, and combinations of any thereof.

10. The method according to claim 12, further comprising limiting coverage for a certain time interval after the initiation of said contractual relationship.

11. The method according to claim 12, wherein the charges for the periodic payments are paid by an employer of natural persons in said contractual relationship.

12. A method comprising:

gathering data about two or more natural persons entering into a contractual relationship;

entering the data into a computer;

calculating, with the computer, a periodic amount to be charged a prospective participant for insurance covering at least some financial consequences in addition to legal fees of the untimely ending of a contractual relationship between the two or more natural persons;

charging that periodic amount in an insurance program over a period of time; and

administering the insurance program with the computer so that upon ending of the contractual relationship, payments covering at least some financial consequences of the ending of the contractual relationship are made as determined by the computer,

wherein the financial consequences comprise, in addition to legal fees, financial consequences selected from the group consisting of moving costs, a former partner's education, health insurance premiums, life insurance premiums, and combinations of any thereof.

13. The method according to claim 12 wherein the periodic amount to be charged a prospective participant is based, in part, on the prospective participant's age and the prospective participant's partner's age.

14. The method according to claim 12 wherein the periodic amount to be charged is calculated, in part, based upon the prospective participant's projected earnings.

15. The method according to claim 12 wherein the periodic amount to be charged is calculated, in part, based upon the prospective participant's partner's projected earnings.

16. The method according to claim 12 wherein the periodic amount charged one of the two or more natural persons is changed in view of changed circumstances in that natural person's life.

17. The method according to claim 16 wherein the changed circumstances are selected from the group consisting of inflation, deflation, educational achievement of one or more of the natural persons, birth of a child, death of a child, disability of one or more of the natural persons, return on investment of investments made with the periodic amounts, and any combination thereof.

18. The method according to claim 12 wherein the periodic amount is a monthly amount.

19. The method according to claim 12 wherein administering the program involves investing at least a portion of the periodic amount.

20. (Canceled).

IX. EVIDENCE APPENDIX

No evidence has been submitted in this case pursuant to 37 C.F.R. § 1.130, 1.131, or 1.132. All evidence referred to in this Brief is comprised in official correspondence between the Examiner and Appellant that is in the record.

X. RELATED PROCEEDINGS APPENDIX

No related proceedings have been identified with respect to the present appeal.